



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

September 21, 2004

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000
US

Dear Sir/Madam,

Your refund request for 10706480 in the amount of \$130.00 has been denied.

The Petition was denied therefore the refund is denied.

Sincerely,

ELEANOR KURTZ
Office of Initial Patent Examination
703 308-3642

57-26-04
Attorney's Docket No. 038190/268379

PATENT & TRADEMARK DIVISION DEP & REF #307

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

In re: Burford *et al.*

Appl. No.: 10/706,480

Applicant Filed: October 27, 2003

USPTO Date Entered: April 7, 2004

For: SYSTEM AND ASSOCIATED FRICTION STIR WELDING (FSW)
ASSEMBLY, CONTROLLER AND METHOD FOR PERFORMING
A FRICTION STIR WELDING OPERATION

Confirmation No.: 8066 2004 JUL 30 PM 3:10
Group Art Unit: 1725



Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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**Request for Reconsideration of
Petition To Grant Filing Date And To Refund Petition Fee**

This is a Request for Reconsideration of our Petition filed April 7, 2004, wherein Applicants petitioned to grant the proper filing date of October 27, 2003, for the above-identified patent application.

Applicants' Petition was dismissed June 10, 2004. The Petitions Examiner has stated that Applicants have not submitted a proper return postcard showing that the application was filed October 27, 2003. However, the Patent Office did not properly stamp Applicants' postcard. Instead, the Patent Office returned Applicants' postcard with the stamp by the Office of License and Review and the date that the Office of License and Review received it. Therefore, it is the Patent Office who improperly stamped Applicants' postcard, thereby leaving Applicants without a properly stamped postcard to produce as evidence.

On October 27, 2003, Applicants sent a United States Postal Service Package to Mail Stop Patent Application (see Exhibit A). The package contained two filings for the same invention: 1) a complete application as outlined on Applicants' return postcard (see Exhibit B); and 2) a Request for Foreign Filing License accompanied by a copy of the specification and drawings as well as another return postcard specifically drawn to the Request for Foreign Filing License (see Exhibit C).

Both of Applicants' postcards are stamped "Received Oct. 30, 2003 Licensing & Review." Applicants can only surmise that when the package was received by Patent Office

In re: Burford *et al.*
Appl. No.: 10/706,480
Applicant Filed: October 27, 2003
USPTO Date Entered: April 7, 2004
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DIVISION

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personnel at Mail Stop Patent Application, the package was not separated out into two different filings, each being separately clipped together by Applicants along with its own postcard. The patent application was not retained for proper processing and stamping of the postcard with an application number and the correct date of October 27, 2003. But instead, the complete application with 25 pages of specification and six pages of drawings and other accompanying documents, as well as the Petition for Foreign Filing License with its copy of the specification and drawings, were forwarded to Licensing and Review, which stamped both postcards October 30, 2003. Only the Petition for a Foreign Filing License and the copy of the specification attached to it with its postcard clipped on top should have been forwarded to Licensing and Review.

As further evidence that the Patent Office did indeed receive a complete copy of the specification and drawings, Applicants also submit herewith as Exhibit D a copy of the foreign filing license granted by the Office of License and Review on October 31, 2003. According to 37 C.F.R. §§ 5.13 and 5.14, when a petition for a foreign filing license is made in the Patent Office, the petition must be accompanied by the material or the disclosure of a patent application upon which the desired license is measured. Since the Office of License and Review granted a foreign filing license for the present application on October 31, 2003, the Patent Office must have had the specification and drawings as the measure upon which the license was granted at least as far back as October 30, 2003, the date stamped on the return postcard and indicated as being the request date on the foreign filing license. Moreover, since the specification and drawings must have accompanied the petition, and the petition for a foreign filing license was included in the aforementioned United States Postal Service Package sent on October 27, 2003, the specification and drawings of the present application must have also been included in the aforementioned package.

Applicants therefore respectfully request that the filing date of October 27, 2003 (the date on the Express Mail Label which date also appears on Applicants' return postcard) be granted. Applicants further believe that if the Examiner cannot grant this date, that there is a preponderance of evidence that the Patent Office had the complete application on October 30, 2003. The Applicants should not be burdened because Patent Office personnel improperly

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In re: Burford *et al.*
Appl. No.: 10/706,480
Applicant Filed: October 27, 2003
USPTO Date Entered: April 7, 2004
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handled the application by forwarding both separately clipped sets of documents to Licensing and Review, and did not hold and process the application that was separately clipped with its own postcard. Moreover, Applicants' petition should not be denied because of the improper processing of the present application and the improper stamping of Applicants' return postcard has left Applicants without the postcard the Petitions Examiner is requesting.

It is Applicants' understanding that there is no charge for a Request for Reconsideration of our Petition. And because no defect existed in Applicants' originally filed patent application, Applicants request a filing date of October 27, 2003, and respectfully also request a refund of the previously paid \$130.00 petition fee.

Respectfully submitted,

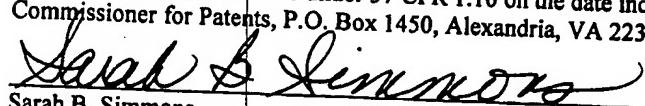


Andrew T. Spence
Registration No. 45,699

CUSTOMER No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

"Express Mail" mailing label number EV 331631265 US
Date of Deposit July 23, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450


Sarah B. Simmons
CLT01/4658231v1

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Exhibit A
Copy of Applicant's U.S. Postal Service Express Mail label.

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Customer Copy
Label TH-F June 2002

		EV 331608718 US	
ORIGIN (POSTAL USE ONLY)			
TO Zip Code: <i>28213</i>	Day of Delivery: <input checked="" type="checkbox"/> Next <input type="checkbox"/> Second	Flat Rate Envelope <input type="checkbox"/>	
Date In: <i>10/27/04</i>	Postage <i>\$ 4.00</i>		
Mo. Day: <i>10/27/04</i>	<input type="checkbox"/> 12 Noon <input type="checkbox"/> 3 PM	Return Receipt Fee	
Time In: <i>6:45</i>	<input type="checkbox"/> Military		
<input type="checkbox"/> AM <input type="checkbox"/> PM	<input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day		
Weight: <i>.5 oz.</i>	Intl Alpha Country Code:	COD Fee	Insurance Fee
No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Acceptance Clerk Initials: <i>M</i>	Total Postage & Fees: <i>\$ 19.85</i>	
METHOD OF PAYMENT: Express Mail Corporate Acct. No. <i>A282641</i>			
FROM: (PLEASE PRINT) PHONE: <i>704 444 1000</i>			
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 S TRYON ST STE 4000 CHARLOTTE NC 28280-4000			
TO: (PLEASE PRINT) MAIL STOP PATENT APPARATION COMMISSIONER FOR PATENTS PO BOX 1450 ALEXANDRIA VA 22313-1450			
HTS: 038190-268379			
<small>Federal Agency Acct. No. 8 Postal Service Acct. No. 10</small>			
<small>PRESS HARD You are making 3 copies. FOR PICKUP OR TRACKING CALL 1-800-222-1811 www.usps.com</small>			

0/27/2003.	(704)359-8838	06:35:28 PM
Product Description	Sales Receipt Unit Price	Final Price
Express Mail 10-ADD Flat		\$13.65
Serial Number: EL822754693US		
Delivery Date: 2nd Day 3PM		
Paid by account: 282641	\$13.65	
EMCA account number: EXANDRIA VA 22313	\$17.85	
Express Mail 10-ADD		
Serial Number: EV331608718US		
Delivery Date: Next Day Noon		
Paid by account: 282641	\$17.85	
EMCA account number: 282641	\$0.00	
Total:		
Paid by:		

Line #: 100040559745
Term: 08

Refunds only per DMH P014
— Thank you for your business —
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PATENT MAINTENANCE
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Exhibit B
Applicant's Patent Application Postcard

This postcard was clipped on top of the complete application filing. All of the documents listed on the postcard were enclosed.

Mail Stop Patent Application
Commissioner for Patents
P.O. Box 1450

Date Mailed: 10-27-03

Alexandria, VA 22313-1450

Atty. Dkt. No. 038190/268379

Kindly acknowledge receipt of the accompanying utility PATENT APPLICATION
with Application Transmittal Cover Sheets for:

Inventor(s): Dwight R. Burford, Edwin H. Fenn, Danny R. High, Robert M. May
Title of Invention: SYSTEM AND ASSOCIATED FRICTION STIR (FSW) ASSEMBLY
CONTROLLER AND METHOD FOR PERFORMING A FRICTION STIR WELDING OPERATION
Pages of Spec. (including claims and abstract) 25; No. of Claims 20
No. of Drawing Sheets 6; Declaration Enclosed YES (3 pages); EDS with PTO
1449 Enclosed YES; (No. of 1449 Cites Enclosed 1); Assignment with Cover
Sheet and \$40.00 Fee Enclosed YES

Other Documents: Request for Early Publication; Petition for License for Foreign Filing
Check(s) Enclosed \$856.00; \$300.00; \$130.00; \$40.00

Please place office stamp hereon and Return Postcard to : Sarah B. Simmons/ATS
ALSTON & BIRD LLP

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PATENT PRACTICE
DIVISION

2004 JUL 30 PM 3:10

Exhibit C

Applicant's Petition for Foreign Filing License Postcard

This postcard was clipped on top of the Petition for Foreign Filing License with a copy of the Specification and Drawings attached.

*ATTENTION: Licensing and Review
Mail Stop Patent Application
Commissioner for Patents*

P.O. Box 1450
Alexandria, VA 22313-1450

Date Mailed: 10-27-03
Atty. Dkt. No. 038190/268379
Application No. (To be assigned); Filing Date (Concurrently herewith)
Inventor(s): Dwight A. Burford, Edwin H. Fenn, Danny R. High, Robert M. Kay; Title of Invention: SYSTEM AND ASSOCIATED FRICTION STIR WELDING (FSW) ASSEMBLY, CONTROLLER AND METHOD FOR PERFORMING A FRICTION STIR WELDING OPERATION

Documents Enclosed: Petition for License for Foreign Filing
Check Enclosed \$130.00
Kindly acknowledge receipt by placing office stamp hereon and
returning postcard to: Sarah B. Simmons/ATS
ALSTON & BIRD LLP

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Exhibit D
Copy of Applicants' Foreign Filing License Granted Oct. 31, 2003

2004 JUL 30 PM
AB



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

SERIAL NUMBER /REQUEST DATE/	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
P-108,155 10/30/03	DWIGHT A. BURFORD, ET AL.	038190/268379

Title:

SYSTEM AND ASSOCIATED FRICTION STIR WELDING (FSW)
ASSEMBLY, CONTROLLER AND METHOD FOR PERFORMING A
FRICTION STIR WELDING OPERATION

Correspondence Address:

ANDREW T. SPENCE
ALSTON & BIRD LLP
BANK OF AMERICA
101 SOUTH TRYON STREET, SUITE 400
CHARLOTTE, NC. 28280

Art Unit	Paper Number
----------	--------------

Alston & Bird

NOV 7 2003

Received by

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 531,532

Grant Date: 31-Oct-03

Approved:

for Commissioner of Patents and Trademarks

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license is granted under 37 CFR 5.15(a)

This license is to be retained by the licensee and may be used at anytime on or after the date thereof.
This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]



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CHARLOTTE NC 28280-4000

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JUN 10 2004

OFFICE OF PETITIONS

In re Application of
Burford, et al.
Application No. 10/706,480 : DECISION DISMISSING PETITION
Filed: April 7, 2004
Attorney Docket No. 038190/268379 :

This is a decision on the "Petition to Grant Filing Date and to Refund Petition Fee", filed April 7, 2004.

Application papers in the above-identified application were deposited on October 27, 2003. However, on March 29, 2004, the Initial Patent Examination Division mailed applicant a "Notice of Incomplete Nonprovisional Application." Applicants were notified that the application papers had not been accorded a filing date because the application was deposited without a specification. This Notice set a two month period for reply.

In response, on April 7, 2004, Applicants filed the present petition to accord a filing date of October 27, 2003. Applicants asserted that a complete application, including a specification, was filed on October 27, 2003. As proof thereof, applicants have submitted: (1) a copy of the original application transmittal letter, bearing Express Mail Label No. EV 331608718 US, and itemizing the items allegedly filed with the application, including 25 pages of specification; (2) a copy of the Express

Mail label bearing Express Mail Label No. EV 331608718 US and a date-in of October 27, 2003; and (3) a copy of a postcard receipt, itemizing the application, but lacking a USPTO date stamp dated October 27, 2003.¹

The PTO file is the official record of papers originally filed in this application. A review of the official file reveals that a specification was not filed on October 27, 2003, since those papers are not present in the file. An applicant alleging that a paper was filed in the PTO and later misplaced has the burden of proving the allegation by a preponderance of the evidence.

A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. See MPEP 503. Applicants have not submitted a proper return postcard showing that the application was filed on October 27, 2003.

Furthermore, petitioner may not rely upon Express Mail under 37 CFR 1.10(e) to establish that the specification was filed with the instant application. MPEP 513 states, in pertinent part:

37 CFR 1.10(e) applies only in those situations in which the correspondence at issue was lost in toto (i.e., the entire correspondence was not delivered to the Office). Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application), an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s) and/or fee(s) were filed in the Office with such correspondence. Rather, where the records of the Office (e.g., the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP § 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.

¹ The postcard receipt did contain a stamp marked "Received October 30, 2003 Licensing and Review."

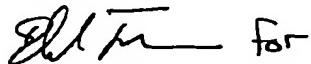
Here, the application file contains some papers that were filed on October 27, 2003; specifically a Utility Patent Application Transmittal, a Request for Early Publication, a 37 CFR 1.63 declaration, and an IDS.

Accordingly, the petition is DISMISSED.

The application will be accorded a filing date based upon the date that the missing specification was received in the Office, or April 7, 2004.

The application file will be forwarded to the Office of Initial Patent Examination for further processing with a filing date of April 7, 2004, using the application papers submitted on October 27, 2003, together with the 25 pages of specification and the 6 sheets of drawings filed on April 7, 2004.

Telephone inquiries related to this decision should be directed to Petitions Attorney Cliff Congo at 703-305-0272.

 for

Charles Pearson
Director
Office of Petitions